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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* YOSHINORI IGUCHI, KATSUMI UTSUGI,
ATSUSHI UEZAKI, JUNICHI WATANABE,
TETSUYA SAITO, and AKIRA MURAKAMI

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Appeal 2009-015128
Application 10/802,837
Technology Center 1700

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Before TERRY J. OWENS, JEFFREY T. SMITH,
and KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-15 and 17-26. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

Claim 1 is illustrative:

> 1. A method of manufacturing glass preforms for press molding by continuously separating glass gobs from a glass melt flow continuously flowing out of a nozzle at a rate of flow and forming the separated glass gobs with glass preform forming members that are intermittently or continuously moving, the method comprising:
>
> moving a support member whereby said support member approaches a front end of the nozzle, so that a front end of the glass melt flow is received by the support member, and then dropping the support member more rapidly than the rate of flow of the glass melt flow to separate a glass gob from the glass melt flow;
>
> transferring the separated glass gob from the support member to a stopped or moving glass preform forming member, which is operative to form a glass preform for press molding; and
>
> forming the glass preform by moving at least one glass preform forming member while cooling the glass to form a solid glass preform, wherein
>
> in the case where the glass gob is transferred to a stopped glass preform forming member, the period during which the glass preform forming member is stopped for transfer of the glass gob from the support member to the glass preform forming member is made shorter than a gob preparation period, defined as the time required for preparing one glass gob from the glass melt flow using the support member and transferring the glass gob to the glass preform forming member.

The Examiner maintains the following rejections[1]:

Claims 1-7, 11-15, and 17-26 under 35 U.S.C. § 103(a) as unpatentable over the combined prior art of Howard (US 1,853,002 issued Apr. 5, 1932 ), Ikeuchi (US 5,738,701 issued Apr. 14, 1998), and Yoshikuni (US 2003/0000252 A1 published Jan. 2, 2003).

[1] The Examiner has withdrawn the rejections made under 35 USC § 112 (e.g., Ans. 2).

Claims 8-10 under 35 U.S.C. § 103(a) as unpatentable over the combined prior art of Howard, Ikeuchi, Yoshikuni, and Murakami (US 2003/0131628 A1 issued July 17, 2003).

ISSUES

1) Did the Examiner err in determining that the combined prior art teaches or suggests the use of a support member that transfers the separated glass gob onto a glass preform forming member as recited in claim 1?

2) Did the Examiner err in determining that the combined prior art teaches or suggests moving a cooled support member downwardly, prior to dripping of the glass gob onto the cooled support member, in such a manner that contact is temporarily broken between the cooled support member and the lower end of the glass melt as required by independent claim 15?

We answer these questions in the affirmative.

PRINCIPLES OF LAW

"[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1256 (Fed. Cir. 2007), quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). As stated by the Federal Circuit:

> [The claims] are part of "a fully integrated written instrument," . . . consisting principally of a specification that concludes with the claims. For that reason, claims "must be read in view of the specification" . . . . [T]he specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term."

*Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc) (internal citations omitted).

During examination, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

After review of the respective positions provided by Appellants and the Examiner, we agree with Appellants that the Examiner has identified insufficient evidence to establish that the combination of Howard, Ikeuchi, and Yoshikuni would have rendered obvious a method for continuously manufacturing glass gobs using a support member and transferring the separated glass gob to a stopped or moving preform forming member as required by the subject matter of independent claim 1[2], or the method as required by the subject matter of independent claim 15[3].

Appellants argue that there is no separate support and preform forming members in Ikeuchi as required by claim 1, and that since there is no separate supporting member and forming member, Ikeuchi cannot teach or suggest the time period as recited in claim 1 (App. Br. 21). Appellants also argue that the combination of Howard and Ikeuchi does not achieve the claimed invention (*id.* at 24).

We agree with Appellants that the Examiner has taken an unreasonably broad interpretation of the aforementioned claim limitations for all of the reasons explained in the briefs (*see, especially*, App. Br. 21; Reply Br. 5, 6). Appellants' Specification details that their invention was

[2] Independent claims 2, 3, 5, 6, 7, 14, and 22-26 each require similar features to claim 1.
[3] Independent claim 20 requires similar subject matter to claim 15.

based on the discovery that separating the front end portion of a glass melt flowing from a nozzle with a "different member" from the glass preform member solved various prior art problems (e.g., Spec. [0016]).

Appellants argue that Ikeuchi and Howard are not combinable to achieve the claimed invention because Howard concerns ancient glass making technology that is inapplicable to continuous production of glass gobs (Reply Br. 8, 11).

Appellants also contend that the Examiner has not reasonably explained how the step of temporarily breaking contact between a cooled support member and the glass melt occurs "prior to dripping of the glass gob onto the support member" with a cooled support member in Ikeuchi as required in claim 15. Appellants contend that the claim language as properly read in light of the Specification requires that the temporary break is during the moving step and thus allows temporary release of the glass gob from the cooled support member (Spec. 43:9-16; see also App. Br. 32; Reply Br. 7, 12, 13;). Furthermore, Appellants point out that the Examiner has not established that cooling the support member of Ikeuchi as required in claim 15 is "a merely trivial extension" over Ikeuchi's teachings as alleged by the Examiner (Ans. 6; Reply Br. 7, 8).

Ikeuchi does not suggest a coolant may be circulated through the support member as required by claim 15. To the contrary, Ikeuchi teaches that while its support member may be room temperature, a *heating coil* 12 is effective for high temperature control to prevent wrinkles from occurring in the glass (col. 5, ll. 1-5).

The Examiner's rejection and response to argument presented in the Answer does not adequately address the concerns raised by the Appellants

outlined above. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Therefore, we are persuaded that the Examiner's interpretation of the disputed claim language is overly broad and not reasonable. As such, we cannot sustain the obviousness rejections which all rely on these flawed interpretations. Appellants' position is supported by a preponderance of the evidence.

For the foregoing reasons, and those presented by Appellants in the Briefs, the Examiner has not satisfied the initial burden of presenting a prima facie case of obviousness, and we conclude that the Examiner's rejection is also improperly based upon improper hindsight reasoning. *KSR*, 550 U.S. at 42 (The fact finder must be aware "of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning;" citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (warning against a "temptation to read into the prior art the teachings of the invention in issue")).

The Examiner has not relied upon the other applied reference to correct this deficiency (*e.g.,* the Examiner has not relied upon Murakami to teach or suggest these features). Accordingly, all of the Examiner's rejections are reversed.

## DECISION

We reverse the Examiner's § 103 rejections.

ORDER

REVERSED

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